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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,542	09/26/2003	Karen Pearse	P-2960-39	5471

7590 07/05/2005

MYRON AMER, P.C.  
Suite 310  
114 Old Country Road  
Mineola, NY 11501

EXAMINER
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BRYANT, DAVID P

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/670,542

**Applicant(s)**

PEARSE, KAREN

**Examiner**

David P. Bryant

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>092603</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubuc (U.S. Patent No. 6,325,435).**

*Claim 1:* Dubuc teaches a method for a factory to replace a jobsite article of manufacture comprising the steps of:

A. designating for replacement a kitchen countertop of a known size in a known dwelling constituting said jobsite (this designation for replacement is implied in column 1, lines 55-60, which refer to customers purchasing and/or ordering solid surface countertops);

B. using a truck 1 (Figure 1; column 2, lines 3-10) having a cutting saw 131 thereon (Figures 7 and 8; column 15, lines 31-37);

C. loading upon said truck a solid surface material slab from a factory characterized in having confines exceeding said known size of said kitchen countertop (column 11, lines 62-64);

D. using in transportation said truck from said factory to said jobsite (column 11, lines 51-52);

E. setting up said slab in cutting relation to said cutting saw (column 14, lines 18-20);

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G. demarcating, by using as a template the original kitchen countertop, a cutting guideline replacement countertop on said slab (column 11, lines 64-67); and

H. cutting, by using said cutting saw, along said cutting guideline (column 11, lines 53-55);

whereby there results in said slab at said jobsite an article of manufacture for replacement for said kitchen countertop removed from said dwelling.

Dubuc fails to teach (1) step F. transferring said kitchen countertop designated for replacement from its location in said dwelling to a position in superposed relation upon and within said confines of said marble slab, and (2) marble as the solid surface countertop material.

The difference between the applicant's method and the method of Dubuc can be summarized as follows:

- In applicant's claimed invention, the original countertop is removed from the dwelling and transferred to the slab in the truck, where the template (i.e. the cutting guideline) is marked thereon for cutting.
- In Dubuc, the slab is carried into the dwelling, the original countertop is used to mark the template (i.e. the cutting guideline) thereon, and the marked slab is returned to the truck for cutting.

The distinction between the two is not of patentable significance; the selection of either marking method is deemed to have been an obvious matter of choice. The novelty of both inventions is to permit fabrication of the countertop at the jobsite by marking the cutting guideline directly on the countertop material using the original countertop. The choice between

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whether that marking is done in the dwelling or in the truck is well within the level of ordinary skill in the art.

It is noted that Dubuc does not explicitly teach marble as the solid surface countertop material. However, the examiner takes Official Notice that marble is a well known countertop material and is cut and fabricated into the countertop using the same techniques as the solid surface material disclosed by Dubuc. Therefore, to utilize the method of Dubuc to fabricate a marble countertop at the jobsite would have been obvious to one of ordinary skill in the art.

Claim 2: The only difference between this claim and claim 1 is the claimed use of stone rather than marble for the countertop. Since stone is also a well known countertop material and is cut and fabricated into the countertop using the same techniques as the solid surface material disclosed by Dubuc, to utilize the method of Dubuc to fabricate a stone countertop at the jobsite would have been obvious to one of ordinary skill in the art.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David P. Bryant whose telephone number is (571) 272-4526. The examiner can normally be reached on Monday-Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David P. Bryant', with a stylized flourish extending to the right.

David P. Bryant  
Primary Examiner  
Art Unit 3726

dpb  
6/27/05